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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,978	02/25/2000	Gerald M. Benson	55250USA1A	9164

32692 7590 07/02/2003

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/02/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-18

<b>Office Action Summary</b>	<b>Application No.</b> 09/515,978	<b>Applicant(s)</b> BENSON ET AL.	
	<b>Examiner</b> Alicia Chevalier	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-37 and 40 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 and 24-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-23 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **RESPONSE TO AMENDMENT**

### ***Continued Prosecution Application***

1. The request filed on April 7, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) is acceptable and a CPA has been established. An action on the CPA follows.

### ***WITHDRAWN REJECTIONS***

2. The 35 U.S.C. §102 rejection of claims 16-23 and 40 as anticipated by Amemiya et al. (5,429,857) of record in paper #6, page 3, paragraph #6 and paper #9, page 2, paragraph #6 has been withdrawn due to Applicant's amendment in paper #13.

3. The 35 U.S.C. §102 rejection of claims 16, 18, 20 and 40 as anticipated by Oshima et al. (5,866,233) of record in paper #6, pages 3-4, paragraph #7 and paper #9, page 2, paragraph #6 has been withdrawn due to Applicant's amendment in paper #13.

4. The 35 U.S.C. §102 rejection of claims 16-23 as anticipated by Bacon, Jr. et al. (5,614,286) of record in paper #6, page 4, paragraph #8 has been withdrawn due to Applicant's amendment in paper #13.

### ***REJECTIONS REPEATED***

5. The 35 U.S.C. §112 rejection of claim 15 is repeated for reasons previously of record in paper #6, page 2, paragraph #3.

6. The 35 U.S.C. §102 rejection of claim 40 as anticipated by Bacon, Jr. et al. (5,614,286) is repeated for reasons previously of record in paper #9, page 2, paragraphs #6.

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7. The 35 U.S.C. §102 rejection of claims 16-23 and 40 as anticipated by Nilsen et al. (5,657,162) is repeated for reasons previously of record in paper #6, page 4, paragraph #8 and paper #9, page 2, paragraphs #6.

8. The 35 U.S.C. §102/103 rejections of claim 15 are repeated for reasons previously of record in paper #6, page 5, paragraphs #10.

### ***NEW REJECTIONS***

9. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Claim Objections***

10. Claim 15 objected to because of the following informalities: dependent from claim 1 which has been cancelled. Appropriate correction is required.

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

11. Applicant's arguments filed in paper #13 regarding the 35 U.S.C. §112 and §102/§103 rejections have been carefully considered but are deemed unpersuasive.

Applicant argues that the rejection is rendered moot by the cancellation of claims 1-8 and claim 15 being withdrawn from consideration in the previous response. While the Examiner agrees that Applicant has canceled claims 1-8 making the 112 rejections over those claims moot, claim 15 has not be withdrawn from consideration. The Examiner is unable to find where in the final office action paper #9, mailed January 2, 2003, that claim 15 was withdrawn from

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consideration and has not seen that Applicant has canceled claim 15. As noted in the acknowledgement of Applicant's election of Group I in paper #6 claim 15 is part of the pending claims. As such claim 15 remains pending and rejected under 35 U.S.C. §112 – 2<sup>nd</sup> paragraph.

12. Applicant's arguments filed in paper #13 regarding the Potential Allowable Subject Matter have been carefully considered but are deemed unpersuasive.

Applicant argues that limitation changes discussed in the telephonic interview on March 3, 2003 would limit the invention of the claims unnecessarily and that the new language in the current amended claims is sufficient. The Examiner feels that Applicant's new language has over come some of the prior art of record but not all of it. However, the Examiner still believes that Allowable subject matter is in the application. As noted in the previous action: the specification has been noted as containing potentially allowable subject matter on pages 13 and 14. The "compound" substrate is described as comprising a replicated substrate with protrusions (pieces) of the machined substrate embedded in the replicated substrate. Therefore, each cube corner cavity (element) comprises a compound face made up of a portion substantially formed or replicated in the replicated substrate and a portion machined in the machined substrate. Essentially, the Examiner finds that the adding the subject matter relating to the fact that only portions of the machined substrate are left embedded in the replicated substrate to create a surface retroreflective cube corner elements to either claim 16 and/or claim 20 to be potentially allowable. The concept is best shown in figure 9.

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***Conclusion***

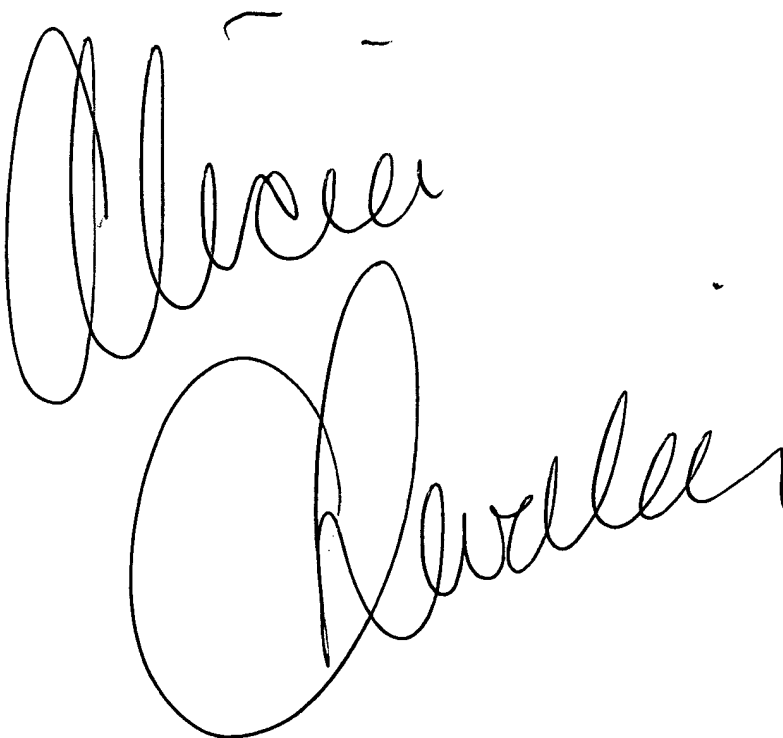
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

6/26/03

The block contains two handwritten signatures in black ink. The top signature is for Alicia Chevalier, written in a cursive style. The bottom signature is for Harold Pyon, also in cursive, and is larger and more prominent than the one above it.